

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Virgil Allen WATSON, et al.
SERIAL NO. : 10/589,012
FILED : April 26, 2007
TITLE : SIGNAGE CONSTRUCTION METHOD AND APPARATUS
Group/A.U. : 1791
Conf. No. : 4193
Examiner : Robert C. Dye
Docket No. : P06721US1

Mail Stop Reply Brief - Patents
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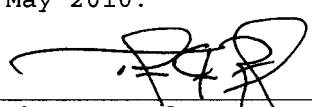
Dear Sir:

REPLY TO EXAMINER'S ANSWER

This brief is submitted in response to the Examiner's Answer of March 19, 2010 and pursuant to 37 CFR § 41.41 in furtherance of the Appeal Brief submitted for this application on February 2, 2010, and Notice of Appeal submitted on December 2, 2009.

Certificate of Electronic Transmission

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via EFS-Web (United States Patent and Trademark Office's web-based patent application and document submission) on this 15th day of May 2010.



Timothy J. Zarley

REMARKS

Claims 2, 4, 6 - 13 and 15 - 19 remain pending in the present application. In response to the Appellant's Appeal Brief, the Examiner has maintained the rejection of all claims. Claims 2 and 4 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams et al. (USP 5,800,757), (hereinafter "Abrams"). Claim 6 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams as applied to claim 2, and further in view of Eberle et al (USP 6,131,320) (hereinafter "Eberle") or Weiner et al. (USP 4,541,190) (hereinafter "Weiner"). Claim 7 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams as applied to claim 2 and further in view of Bowers et al. (PG Pub 2003/0154639) (hereinafter "Bowers"). Claim 8 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Abrams in view of Bowers as applied to claim 7 and further in view of Wardle (USP 4,131,657) (hereinafter "Wardle"). Claims 9, 10, 11, 12, 15 and 19 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts (WO03/016017) (hereinafter "Alberts") in view of Abrams. Claim 13 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams as applied to claim 12 and further in view of Assalita et al. (USP 5,922,367) (hereinafter "Assalita"). Claim 16 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams as applied to claim 15 and further in view of Hasl et al (USP 4,880,368) (hereinafter "Hasl"). Claims 17 and 18 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Alberts in view of Abrams and Hasl as applied to claim 16 and further in view of Hellmer et al. (USP 4,397,625) (hereinafter "Hellmer"). The Applicant believes all claims are in proper

form for allowance and therefore respectfully requests withdrawal of the present rejections.

Claim 2 requires, in-part, "*wherein the second object is a second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label.*" (emphasis added). In maintaining the rejection over Abrams, Appellee, in the Answer in response to Appellant's Appeal Brief argues that "claim 2 does not define a distinct structure for the claimed mounting feature" and asserts that Applicant has not claimed any unique feature that the mounting means must have to enable it to attach to a second sign, and thus, because Abrams has mounting features located on the side opposite the label to allow for attachment to a variety of second objects, it would have been obvious to employ mounting features adapted to attach the sign to a second sign. (See Examiner's Answer, ¶ 10, pages 13 - 14).

Appellant cannot agree, as claim 2 requires, in part, "*wherein the planar substrate includes a mounting feature adapted to secure the sign to a . . . second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label.*" (emphasis added) Such limitations not only define distinct structure and unique features with respect to the requirements of the mounting feature, but also such limitations are also not met or rendered obvious by Abrams. Appellee recognizes that Abrams fails to explicitly disclose that the backboard of Abrams mounted to a second sign, but also Abrams backboard includes holes 220 through the backboard which receive pins to mount the backboard onto a frame, thus requiring that the heads of the pins or bolts, forming part of the mounting feature, contact the front of the backboard and thus cannot

meet claim 2's limitation of a mounting feature formed into the planar substrate of the sign specifically adapted to secure the first sign to the back end of a second sign. (See Abrams, Figs. 19 & 20, col. 19, lines 10 - 35).

Elberle similarly cannot cure Abrams, as Elberle's disclosure is limited to male and female hinge projections 16 and 18 integrally formed with the display panels axially moveable in sliding engagement, and thus Elberle cannot meet the limitations of claim 2 requiring that the mounting feature secures the first sign to the back side of the second sign located opposite from the label. (See Elberle, col. 3, lines 36 - 61). Finally, Bowers fails to meet the limitations of claim 2 not taught by Abrams and Elberle, as Bower's disclosure is limited to connecting frames in an adjacent, side by side relation as shown by Figure 7, but does not disclose a mounting feature secures a first sign to the back side of the second sign located opposite from the label required by claim 2. (See Bowers, Figs. 5 & 7, para. [0033]). For the above reasons, the prior art to Abrams, Eberle and Bowers, individually, or in combination, fails to teach each and every limitation of Applicant's claim 2, and Appellant requests that the rejection be withdrawn with respect to both claim 2 and all additional claims dependent upon claim 2.

Claim 9 requires, in part, "associating an injection device with the first sign mold portion; associating an ejector system with the first sign mold portion. . . wherein the ejector system contacts the formed sign on a side opposite from the label." In maintaining the rejection of the pertinent language of claim 9 over the Alberts reference, Appellant recognizes that Alberts discloses a suction cup system that contacts the product on the label side, but

instead relies upon Albert's disclosure (in part) that "different ejection means can be provided for removing products from the mold cavities 14, for instance conventional ejection pins", concluding that "[s]ince the article of Alberts is molded such that the label is located on the surface opposite the cavity surface 14, locating a conventional ejection pin system in cavity 14 as suggested by Alberts would intrinsically result in the pins contacting the non-label side of the formed article. (See Examiner's Answer, ¶ 10, page 15, 2d full paragraph - page 16 citing Alberts) (emphasis).

Appellant cannot agree, because Alberts suggestion of an ejector system in one of the mold cavities 14 would not necessarily result in the ejector system contacting the formed sign on the side opposite from the label, as required by claim 9. Inherency permits, in very limited circumstances that an invention is rejected over prior art that is lacking minor, well-known features in the claimed invention. Irah H. Donner, Patent Prosecution 326 (Lowe, Price, LeBlanc & Becker 1996). Evidence of inherency "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 20 USPQ 2s 1746, 1749-50 (Fed Cir. 1991). Inherency may not be established by probabilities or possibilities, and consequently the mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). That is, the missing element or function must necessarily result from the prior art reference. Id.


As cited by the Examiner, Alberts doesn't define the mold cavity as only being associated with one mold part, but instead defined multiple cavities 14 on either side of the transfer device 4. (See Alberts, Fig. 6). Thus, because Alberts is silent as to which side of the mold or mold cavity the ejection device is located, ("different ejection means can be provided for removing products from the mold cavities 14, for instance conventional ejection pins" (Alberts, p. 12, lines 9 - 11)), and notwithstanding whether transfer part 38 is required, Alberts does no more than generally disclose ejection means for removing parts in the mold cavities and does not explicitly teach or require an ejector system which contacts a formed sign on a side opposite from a label as required by claim 9. Therefore, because neither Alberts nor Abrams, alone or in combination, disclose an ejector system that contacts a formed sign on a side opposite from the label, the references cannot combine to meet each and every limitation of claim 9. Accordingly, the Appellant respectfully requests that the rejection be withdrawn with respect to both claim 9 and all additional claims dependent upon claim 9.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

There are no fees or extensions of time believed to be due in connection with this reply; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'T. Zarley', with a long horizontal line extending to the left.

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